



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,344	10/17/2003	Tatsuo Itabashi	9792909-5712	2279

26263 7590 03/30/2007
SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
----------	--------------

2141

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/688,344	Applicant(s) ITABASHI ET AL.	
	Examiner Kenneth R. Coulter	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21, 24-30 and 33-46 is/are rejected.
- 7) ☒ Claim(s) 22, 23, 31 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/27/06; 2/2/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

"This holds true the a personal computer" (Abstract).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 17 – 21, 24 – 30, and 33 – 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al. (U.S. Pat. No. 5,933,811) (System and Method for Delivering Customized Advertisements Within Interactive Communication Systems)

- 3.1 Regarding claim 17, Angles discloses an information processing method in an information processing apparatus for processing information between a plurality of

Art Unit: 2141

service providers and a user, wherein each of the plurality of service providers has a corresponding service provider device, the method comprising the steps of:

storing personal information of the user (col. 3, lines 6 – 29 “The advertisement provider’s computer stores demographic information about consumers, ... The advertisement provider then retains a demographic profile of the consumer.”; col. 8, lines 8 – 19 “demographic database”);

receiving a request to perform a transaction with one of the plurality of service provider devices from the terminal device operated by the user (Fig. 3, item 302; col. 8, lines 34 – 43 “the consumer computer 12 requests an electronic page 32 from the content provider computer 14”);

identifying a manner in which the personal information will be used by one of the plurality of service provider devices (Abstract “the advertising provider computer generates a custom advertisement based on the consumer’s profile.”; Fig. 3, item 310; col.. 3, lines 6 – 18 “sends customized advertisements to the consumers based on the consumers demographic profile”);

identifying one or more items requested by one of the plurality of service provider devices from the stored personal information (Abstract; Fig. 9; col. 21, lines 34 – 52);
and

sending the manner or the one or more items requested by said service provider device to the terminal device to be displayed at the terminal device (Abstract; Fig. 9; col. 21, lines 34 – 52).

Art Unit: 2141

3.2 Per claim 18, Angles teaches that said manner requires that said personal information is to be used only by one of the plurality of service provider devices (Fig. 4, items 12, 18; Fig. 8; col. 20, lines 45 – 56).

3.3 Regarding claim 19, Angles discloses that the personal information is to be provided by one of the plurality of service providers to another one of the plurality of service providers for use (Fig. 2, items 14, 18; Fig. 9, items 14, 18; col. 21, lines 38 – 52).

3.4 Per claim 20, Angles teaches that said terminal device comprises a **wireless device** comprising one of a **PDA**, a mobile telephone, a personal handyphone, a pager, a laptop computer and a handheld information processing device (col. 10, lines 33 – 42 “the consumer computer 12 could, for example, be a computer workstation, ..., a **personal digital assistant, an interactive wireless communications device or the like** which can interact with the communication medium 20.”).

3.5 Regarding claim 21, Angles discloses that said personal information comprises one or more of a user payment information, a user home address, a user email address, a user telephone number, a user date of birth, a user password, and a user ID (col. 17, lines 3 – 10 “the consumer enters information which includes, **but is not limited to, age, sex, income, career, interests, hobbies, consumer preferences, the account number of the consumer’s Internet provider 34, other account information, etc.**”).

Art Unit: 2141

3.6 Per claim 24, Angles teaches retrieving a reply from said user (Fig. 7, items 716, 720; col. 20, lines 18 – 26; col. 20, lines 38 – 44).

3.7 Regarding claim 25, Angles discloses processing the transaction on the basis of said reply from said user (Fig. 7, items 716, 718; col. 20, lines 18 – 26).

3.8 Per claims 26 – 30, 33 – 46, the rejection of claims 17 – 21, 24, and 25 under 35 USC 102(e) (paragraphs 3.1 – 3.7 above) applies fully.

Response to Arguments

4. Applicant's arguments with respect to claims 17 – 21, 24 – 30, and 33 – 46 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

5. Claims 22, 23, 31, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M – F, 7 am – 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KENNETH R. COULTER
PRIMARY EXAMINER


krc